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ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036			BRUENJES, CHRISTOPHER P	
			ART UNIT	PAPER NUMBER
			1772	

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Please find below and/or attached an Office communication concerning this application or proceeding.



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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on December 1, 2005 is acknowledged. The traversal is on the ground(s) that the method and product claims are sufficiently related to be examined together. This is not found persuasive because although admittedly the method and product claims both recite the composition and structure the product claimed is not required to be used in the same manner as the claimed method. Specifically, the product claimed could be used in a method of painting a wall rather than legs.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 1, 2005.

### ***Claim Objections***

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3. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 already incorporates a composition comprising said coloring agent, cosmetic and propellant and further teaches that the composition is an aerosol. Therefore, claim 5 either teaches a broader definition of the composition of claim 1 or teaches all of the limitations already claimed in claim 1.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "in which a coloring agent selected from pigments, dyes, pearly lusters, silk powder and fillers, a cosmetic and a propellant are housed as an

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aerosol render the claims vague and indefinite. It is not understood whether the combination of illustrative medium and container includes merely a container that houses the composition claimed or if the combination claimed includes the composition claimed. Specifically, merely stating that a container houses an aerosol of a certain composition does not necessarily positively claim that particular composition. Instead claiming that a container houses a certain composition can mean either that the container actually contains the composition as claimed or that the container has the ability to house that composition. Furthermore, the limitation "selected from" in line 3 appears to represent a Markush group, but should be written in proper Markush language in order to render the limitation more definite. Therefore, it is suggested that "selected from" be amended to "selected from the group consisting of".

Regarding claims 6, 12, and 25, the limitation "by weight" renders the claims vague and indefinite because it is not understood what percentage by weight is based on. For instance is the total include the weight of the separate components of the composition or does the weight also include the container and the outer packaging.

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Regarding claim 22, the limitation in line 2 "a container of a sprayable composition" renders the claim vague and indefinite. It is not understood if the limitation is redefining container to mean sprayable composition, or if the container walls are somehow formed of sprayable composition, or if the container contains a sprayable composition within the enclosure formed by the walls of the container. Therefore, it is not clear if the claimed invention includes a package a container and a sprayable composition or just a package enclosing a sprayable composition that is a container.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wysocki (USPN 4,261,462).

Wysocki anticipate a unit, which is composed of a combination of a container formed in a can or a steel bottle and an illustrative medium made up of descriptive text and/or images

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(see abstract and Figures 1 and 8). Note the limitation "a unit forming a stocking-like layer on stocking-less legs" is an intended use presented in the preamble and therefore receives little patentable weight. The structure of the unit is described in the body of the claim to include a container and illustrative medium and the limitation that the unit is used to form a stocking-like layer on stocking-less legs does not provide any additional structural limitations to the claim. The limitation "a container formed in a can or steel bottle in which a coloring agent selected from pigments, dyes, pearly lusters, silk powder and fillers, a cosmetic and a propellant are housed as an aerosol" is defined by the broadest reasonable interpretation of the limitation. In this case, the limitation is defined as a container that houses the composition claimed, but does not require that the composition be present in the container to anticipate the claim. The container merely must have the ability to house the claimed composition not that the container must contain the composition. Therefore, since the container of Wysocki is used for containing cosmetic preparations (col.3, 1.10-14), it has the ability to house the claimed composition of claims 1 and 6-12 and therefore anticipates the claims as claimed. The unit further comprises an illustrative medium made up of descriptive text and/or images

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as a label on the container (reference number 110, Figures 8-10) or printed directly on an outer packaging for the container (col.3, 1.47-52). The direct printing on the outer package teaches the limitations of claim 2, and the label teaches the limitations of claims 3-4. Finally, the limitation that the illustrative medium "informs users that a stocking-like layer is formed by directly spray-jetting the above coloring agent along with the cosmetic on stocking-less legs" is a limitation directed at non-functional printed matter. Nonfunctional printed matter does not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

***Claim Rejections - 35 USC § 103***



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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-8, 10-11, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bara (US 2003/0108487 A1) in view of Wysocki (USPN 4,261,462).

Regarding claims 1-8 and 10-11, Bara teaches a container formed in a can or a steel bottle (Figure 1) comprising a coloring agent such as iron oxide, titanium oxide, zinc oxide, inorganic pearlescent agents, mica or silica (p.2, paragraphs 36-38). The total solid content is more than 0.3% so the

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coloring agents is obvious included in an amount of 0.15% by weight based on the total aerosol. The container further houses a cosmetic (p.1, paragraph 1) and a propellant (p.3, paragraph 66). Note the limitation "a unit forming a stocking-like layer on stocking-less legs" is an intended use presented in the preamble and therefore receives little patentable weight. The structure of the unit is described in the body of the claim to include a container and illustrative medium and the limitation that the unit is used to form a stocking-like layer on stocking-less legs does not provide any additional structural limitations to the claim.

Bara fails to teach that the unit further comprises an illustrative medium made up of descriptive text and/or images. However, Wysocki teach that it is well known in the art to provide illustrative mediums in the form of labels directly to a container for cosmetic preparations and also directly printed on outer packaging of bottles containing cosmetic preparations in order to provide information and directions on use of the contained cosmetic. In particular, the direct printing on the outer package teaches the limitations of claim 2, and the label teaches the limitations of claims 3-4. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the two references are

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analogous insofar as both references are concerned the packaging of cosmetics, and that illustrative text and/or images are applied to containers for cosmetics as well as outer packaging for the same, in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add illustrative text and/or images as taught by Wysocki to the cosmetic container of Bara in the form of a label and/or outer packaging in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Note that the limitation that the illustrative medium "informs users that a stocking-like layer is formed by directly spray-jetting the above coloring agent along with the cosmetic on stocking-less legs" is a limitation directed at non-functional printed matter. Nonfunctional printed matter does not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In

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this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

Regarding claims 22-24, Bara teaches a container of a sprayable composition comprising a propellant, coloring agent, and a carrier as described above. The limitation that the composition is "for applying to legs of a user to simulate stockings on the legs" is an intended use/functional limitation that receives little patentable weight in a product claim because articles are defined by structure, not what the article does. In this case, the sprayable composition is applied to skin for cosmetic purposes (p.1, paragraph 1) and has a colorant, so therefore could be used for applying to legs of a user to simulate stockings on the legs. Thus, since the composition is formed of the same components it meets the structural limitations and since the article is capable of performing the functional limitation it anticipates the claimed composition. Bara fails to teach the container being enclosed in a package and printed instructions for applying the sprayable composition. However, Wysocki teaches the outer packaging and printed medium and is combinable with Bara for the reasons set forth above with regard to claim 1.

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7. Claims 1-12 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganguly et al (US 2005/0142084 A1).

Regarding claims 1-12, Ganguly et al teach a cosmetic composition for leg paint (p.2, paragraph 15) comprising a coloring agent made of pigments formed of mica, titanium dioxide, zirconium dioxide, silica, or iron oxide (p.2, paragraphs 17-19). The coloring agent also comprises silk powder as a bulking agent (p.3, paragraph 23). The composition further comprises a cosmetic and a film-forming polymer (p.2-3, paragraph 23). The pigments are found in an amount of 0.15% by weight and the film formers are found in an amount between about 0.25 and 40% by weight (p.3, paragraph 26). The composition is further described as being in the form of an aerosol (p.4, paragraph 27). Note the limitation "a unit forming a stocking-like layer on stocking-less legs" is an intended use presented in the preamble and therefore receives little patentable weight. The structure of the unit is described in the body of the claim to include a container and illustrative medium and the limitation that the unit is used to form a stocking-like layer on stocking-less legs does not provide any additional structural limitations to the claim.

Ganguly et al fail to teach that the composition is found in a can or a steel bottle or that it contains a propellant.

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However, Bara teaches that aerosol cosmetic compositions are placed in a can or a steel bottle in combination with a propellant in order to render the aerosol sprayable so that the aerosol cosmetic composition can be sprayed onto the user's skin (see abstract and p.1, paragraph 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to place an aerosol cosmetic composition in a can or steel bottle in combination with a propellant in order to render the aerosol cosmetic composition sprayable so as to be sprayed onto an user's skin, as taught by Bara.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made store the aerosol cosmetic composition of Ganguly et al in the container containing a propellant of Bara in order to render the composition sprayable so as to be conveniently sprayable onto the user's skin, as taught by Bara.

Ganguly et al and Bara fail to teach that the unit further comprises an illustrative medium made up of descriptive text and/or images. However, Wysocki teach that it is well known in the art to provide illustrative mediums in the form of labels directly to a container for cosmetic preparations and also directly printed on outer packaging of bottles containing

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cosmetic preparations in order to provide information and directions on use of the contained cosmetic. In particular, the direct printing on the outer package teaches the limitations of claim 2, and the label teaches the limitations of claims 3-4. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the three references are analogous insofar as the references are concerned with cosmetics and the packaging thereof, and that illustrative text and/or images are applied to containers for cosmetics as well as outer packaging for the same, in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add illustrative text and/or images as taught by Wysocki to the cosmetic container of Bara in the form of a label and/or outer packaging in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Note that the limitation that the illustrative medium "informs users that a stocking-like layer is formed by directly spray-jetting the above coloring agent along with the cosmetic on stocking-less legs" is a limitation directed at non-functional printed matter. Nonfunctional printed matter does

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not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

Regarding claims 22-24, Ganguly et al and Bara teach a container of a sprayable composition comprising a propellant, coloring agent, and a carrier as described above. The limitation that the composition is "for applying to legs of a user to simulate stockings on the legs" is an intended use/functional limitation that receives little patentable weight in a product claim because articles are defined by structure, not what the article does. In this case, the sprayable composition is applied to skin for cosmetic purposes (p.1, paragraph 1) and has a colorant, so therefore could be used for applying to legs of a user to simulate stockings on the legs. Thus, since the composition is formed of the same components it meets the structural limitations and since the article is



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capable of performing the functional limitation it anticipates the claimed composition. Ganguly et al and Bara fail to teach the container being enclosed in a package and printed instructions for applying the sprayable composition. However, Wysocki teaches the outer packaging and printed medium and is combinable with Ganguly et al and Bara for the reasons set forth above with regard to claim 1.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Granger et al (US 2002/0001603 A1); Love et al (US 2003/0184773 A1); Gibson et al (USPN 5,559,092); Rhoades (US 2004/0045856 A1); Van Rosen (USPN 2,360,806); Ron et al (USPN 6,316,011).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB *CPB*  
January 5, 2006

*[Signature]*  
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*1/6/06*